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10/625,271	07/23/2003	Terry R. Hobbs	58017US002	8409

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EXAMINER

PAK, JOHN D

ART UNIT PAPER NUMBER

1616

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/625,271

Applicant(s)

HOBBS ET AL.

Examiner

JOHN PAK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 28-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10, 13-20, 24-27, 37 and 38 is/are rejected.
- 7) ☒ Claim(s) 11, 12 and 21-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/23, 10/04, 11/04, 2/05, 3/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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Claims 1-38 are pending in this application.

Applicant's election without traverse of the invention of Group I in the reply of 2/23/2005 is acknowledged. Accordingly, claims 28-36 are withdrawn from further consideration as being directed to non-elected subject matter. Claims 1-27 and 37-38 will presently be examined to the extent that they read on the elected subject matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-10, 13-18, 24-27, 37 and 38 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Toussaint et al. (US 6,444,636).

Toussaint et al. explicitly disclose a liquid composition that contains, inter alia, the following ingredients at pH 3-6:

0.05-5 wt% hydrogen peroxide;

0.1-5 wt% acids such as orthohydroxy benzoic acid, salicylic acid, and mixtures;

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16-30 wt% alkali metal ammonium or alkaline earth metal sulfonate surfactant;

7-16 wt% alkali metal salt of a sulfate surfactant;

1-10 wt% glycol ether;

0.1-5 wt% polyethylene glycol.

See claim 1. C<sub>12-13</sub> paraffin sulfate is disclosed as an exemplary sulfate surfactant (Example 1 on column 6). pH range of 3.5 to 4.5 is exemplified (Example 1).

The claims are thereby anticipated for reading on the prior art composition by Toussaint et al. The kill rate feature in claim 2 is noted, but such feature is deemed to be an inherent characteristic of Toussaint's composition that contains the same exact ingredients as applicant's composition. Additionally, such kill rate can depend on the challenge level and the particular bacteria strain. As a result, when the Examiner can show a prior art composition that contains the same ingredients as the claimed invention, the burden of showing that the prior art composition does not somehow have the same properties shifts to applicant. MPEP 2112, 2112.01. The claim features, "concentration sufficient to [provide microbicidal action or synergy]" is noted, but such concentrations are already necessarily disclosed by Toussaint et al. by virtue of their disclosing concentrations that read on applicant's concentration range. Claim 18 recites "further comprising a salt of the aromatic acid at a concentration less than about 2% by weight." The Examiner's interpretation of such claim language is that it is open to 0% since "less than about 2% by weight" does not specifically set the low end of the range.

Claim 26 requires the composition to be more resistant to catalase deactivation than an aqueous solution of hydrogen peroxide. The Examiner's position is that since Toussaint's composition contains the same ingredients as applicant's composition, the same resistance must necessarily be present. Method of claim 37 is noted but such method would necessarily have been obtained from Toussaint's teachings since the ingredients must be combined in order to obtain the mixture of ingredients. The skin feature of claim 38 is noted but since dish cleaning compositions must be suitable to the skin, said feature is necessarily deemed to be present in Toussaint's composition. All other claim features are plainly encompassed by Toussaint's composition, as shown above.

Claims 1-3, 5-8, 10, 13-18, 26-27, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Devillez (5,736,582).

Devillez explicitly discloses a skin treating composition that contains, inter alia, the following ingredients at pH 4.6:

3.5 wt% hydrogen peroxide (calculated from 10% of a 35% solution);

1 wt% salicylic acid;

1.67 wt% cetyl alcohol;

74.8 wt% distilled water;

0.3 wt% sodium hydroxide;

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0.06 wt% simethicone (has antifoam properties);

0.31 wt% sodium lauryl sulfate;

1.86 wt% Promulgen G (stearyl alcohol + cetareth-20)

See column 6, lines 45-56 and column 7, lines 28-30.

The claims are thereby anticipated. The kill rate feature in claim 2 is noted, but such feature is deemed to be an inherent characteristic of Devillez's composition that contains the same exact ingredients as applicant's composition. Additionally, such kill rate can depend on the challenge level and the particular bacteria strain. As a result, when the Examiner can show a prior art composition that contains the same ingredients as the claimed invention, the burden of showing that the prior art composition does not somehow have the same properties shifts to applicant. MPEP 2112, 2112.01. Claim 3 requires both an aromatic acid and a salt of the aromatic acid. It is noted that Devillez's composition has sodium hydroxide added to it, q.s. pH 4.6. Sodium hydroxide would then necessarily produce the salt form of the acid and render some salt form to be present in the composition. See for example applicant's agreement on this point (in situ salt) in the instant specification, page 9, lines 1-3. Claim 26 requires the composition to be more resistant to catalase deactivation than an aqueous solution of hydrogen peroxide. The Examiner's position is that since Devillez's composition contains the same ingredients as applicant's composition, the same resistance must necessarily be present. Method of claim 37 is noted but such method would necessarily have been

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obtained from Devillez's teachings since the ingredients must be combined in order to obtain the mixture of ingredients. All other claim features are plainly encompassed by Devillez's composition, as shown above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 20, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillez.

The discussion of Devillez's teachings as set forth above is incorporated herein by reference. With respect to the rejected claims under section 103, the following further comments are in order.

The salicylic acid exemplified in the example on column 6, lines 45-56 can be interchanged with benzoic acid (column 3, lines 28-35). Similar to the in situ generation of the salicylate salt, benzoate salt would be formed in situ due to the addition of sodium hydroxide.

One having ordinary skill in the art would have been motivated to substitute benzoic acid with salicylic acid with the expectation that similar treatment would be obtained because their interchangeability is specifically suggested by Devillez.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited reference.

Subject to a search update and review at the time of the next Office action, claims 11-12 and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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